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EXAMINER

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Attachment to Advisory Action

Applicants' amendment filed on 1/28/2010 has been entered Applicants' arguments have been fully considered but are not persuasive for the reasons set forth below.

1. Given Applicant's amendment of claims 50 and 51, the rejection of claims as failing to comply with 35 U.S.C 112 second paragraph is thereby withdrawn.
2. Applicants state that they do not under the rejection of claim 48 under 35 U.S.C. 112 first paragraph. Previously, set rejection set forth the following:
Claim 48 recites that the biocide is incorporated into the water re-dispersible polymer powder by spray drying". While the Specification, specifically the Abstract, discloses that biocides are added to the re-dispersible polymer powder, there is no explicit support in the Specification that the biocides are "incorporated into" the water re-dispersible polymer as recited in the present claims. That is to say that while the Specification discloses that biocides added to the re-dispersible polymer powder, there is no support for the narrower limitation recited in claim 48 that the biocide is incorporated into the polymer, i.e. the biocide is embedded, encapsulated, found within the polymeric matrix, etc. Further, it is the noted that the Specification Page 9, Lines 1-6 supports the biocide being "mixed into" aqueous dispersions preferably by spray drying. Given that the phrase "mixed into" is not exactly synonymous with "incorporated into", and given that the latter carries a connotation that goes beyond mere mixing as discussed above, an issue of written

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descriptive support under 35 U.S.C. 112, first paragraph for the claimed terminology is thereby raised.

In conclusion, given that there is no support in the Specification as originally filed for the limitation that "the biocide is incorporated into the water redispersible polymer" as presently recited, the rejection of claim 48 as failing to comply with 35 U.S.C. 112 first paragraph is therefore maintained.

3. Applicant argues that the difference between claim 49 and Wetzel is that the claim is drawn to a biocidal additive which is "selected from the group consisting of bactericide actives, fungicide actives and algicide actives" (i.e. a recitation in Markush format) whereas Wetzel discloses an active biocide "in a host cavity" which, according to Applicant, is outside the scope of the "actives" recited in the claim. This argument is unpersuasive given that nowhere in the original disclosure is there any indication that said "actives" are so defined as to exclude a host cavity or any other medium. Indeed, it is proper to hold that as long as Wetzel discloses a biocidal additive that functions as an "active" ingredient, regardless of the presence of any other moiety such as a host cavity, provided that said moiety does not adversely affect the activity of the "active" (and there is no evidence that such is the case here), then Wetzel's biocidal additive meets the corresponding additive in recited in the present claims.

4. Applicant argues that claim 50 requires that the biocide is selected from the group consisting of biocide actives. It is unclear why Applicant presents this argument given that claim 50 is clearly devoid of such claim language.

5. Applicant argues that Weitzel teaches away from using neat actives and is directed to the use of cyclodextrin complexes of both photoinitiators and fungicides. However attention is drawn to Paragraph [0008] of the reference which discloses the following "[b]y employing a photoinitiators and/or fungicide complexed with cyclodextrin...". Furthermore, claim 1 of the reference recites "[o]ne or more photoinitiators and/or fungicides," "[w]herin the photoinitiators and/or fungicides are in the form of complexes with cyclodextrin or its derivatives". Given the disclosure of "and/or" in the reference, it is clear that either both the photoinitiator and biocide are in the form of a complex or one of the two, i.e. either the photoinitiator or biocide. That is to say, the reference does not require both the photoinitiator and biocide to be in the form of a complex.

6. Applicant argues the combination of references, Weitzel in view of Botts by arguing that the spray drying technique disclosed in Botts is different from that utilized in the present invention. However, firstly is noted that the claim 47 drawn to the process of forming the presently claimed composition merely recited admixing the ingredients while claim 48 which depends from 47 recites that the biocide, isothiazolinone or benzimidazole, is incorporated into the water redispersible polymer composition by spray drying". The claims do not recite that that the redispersible polymer must be is solid particulate form prior to spray drying, but merely require incorporation of the biocide into the polymer by spray drying. In response to Applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which

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applicant relies (i.e., the polymer must exist in solid particulate form prior to spray drying) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims.

See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Secondly, it is noted that Botts discloses the benefits of spray drying compositions comprising active compounds, i.e. sustained and controlled release of the active compounds. Thus, Applicants are reminded that according to MPEP 2141.01 (a), a reference may be relied on as a basis for rejection of an applicants' invention if it is "reasonably pertinent to the particular problem with which the inventor is concerned." A reasonably pertinent reference is further described as one which "even though it maybe in a different field of endeavor, it is one which, because of the matter with which it deals, logically would have commended itself to an inventor's attention in considering his problem." Botts is, therefore, a reasonably pertinent reference, because it teaches spray drying as a method for entrapping active ingredients in a polymer matrix in order to obtain sustained release, which is a function especially pertinent to the invention at hand.

Furthermore, it is noted that while Botts does not disclose all the features of the present claimed invention, the reference is used as teaching reference, and therefore, it is not necessary for this secondary reference to contain all the features of the presently claimed invention, *In re Nievelt*, 482 F.2d 965, 179 USPQ 224, 226 (CCPA 1973), *In re Keller* 624 F.2d 413, 208 USPQ 871, 881 (CCPA 1981). Rather this reference teaches a certain concept, namely benefits of spray drying processes as a method to entrap biocidal compounds for sustained and controlled release of these compounds, and in combination with the primary reference, discloses the presently claimed invention. If the secondary

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reference contained all the features of the present claimed invention, it would be identical to the present claimed invention, and there would be no need for secondary references.

7. Applicant argues the double patenting rejection of the present claims over claims 1-3, 5, 11-13, 15, and 17 of U.S. Patent No. 6,740,692 (US '692) as set forth in Paragraph 15-17 of the previous Office Action by comparing Example 6 and comparative Example 8 of US '692; Example 6 contains an uncomplexed biocide while comparative Example 8 of contains a neat and complexed biocidal compounds, respectively. However, as discussed above in Paragraph 3, the present claims do not exclude in any way the use of complexed or uncomplexed biocidal compounds but rather broadly recites that the composition comprises a water redispersible polymer power and at least one biocidal additive selected from the group consists of bactericide active(s), fungicide active(s) and algicide active(s). In light the language in the present claims and the discussion set forth above, the double patenting rejection of the present claims over US '692 is maintained.

2/3/2009

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